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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/727,984

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Steve Lemke

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EXAMINER

PICH, PONNOREAY

ART UNIT

PAPER NUMBER

2135

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/727,984	LEMKE, STEVE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ponnoreay Pich	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-6 and 8-22 are pending. Any objections or rejections not repeated below for record are withdrawn due to applicant's amendments and/or arguments. Any well known art statements in the prior office action not specifically traversed by applicant are taken as admittance of prior art as per MPEP 2144.03C.

#### ***Response to Amendment and Arguments***

Applicant's amendments have been fully noted. Applicant's arguments have also been fully noted, but are not persuasive.

Applicant argues Borza does not teach that the biometric data be stored on the network and at the wireless device. The examiner respectfully disagrees. Borza discloses that in his invention, biometric data is stored in the transmitting module and an access code is sent to the receiving module for comparison (p9, lines 1-2). Borza discloses his transmitting module to be a wireless portable computing device (Fig 1, item 10 and p8, lines 1-2). Since the access code transmitted to the receiving module is dependent on the comparison done in the transmitting module of the biometric data stored in the transmitting module, the access code can be interpreted as biometric data. The receiving module is part of the network. Thus biometric data is stored in both the portable computing device and in the network. One should also appreciate that a portable wireless device, which is connected to a network, is also part of the network, so even if there was no data transmitted to the receiving module for further comparison, any data stored in the portable wireless device is also stored on the network once the portable wireless device has connected to the network. Further, another interpretation

of the combination invention of Borza and Deo also discloses the limitation being argued. Borza discloses the biometric data being stored on the network (p8, lines 27-28 and p15, lines 10-25). Deo discloses authorization data being stored on a portable computing device (col 23, lines 56-65). One skilled should appreciate that biometric data is a type of authorization data. Thus, it would have been obvious to one skilled to combine the teachings of Borza and Deo such that authorization data was stored on both the network and on the portable wireless device, wherein the authorization data was biometric data. One skilled would have been motivated to modify Borza's invention to also store the authorization data in the portable computing device because it would allow a user to be able to authenticate and use the device even in the case of a network outage. This is a similar concept behind how one can use a laptop whether the laptop is attached to a network or not. If a laptop was attached to a network, the user would be authenticated to both the network and the laptop whereas if there was no network connection, the user would only be authenticated to the laptop and not have any network access, yet could still run programs available on the laptop.

Applicant argues Deo's system would not be able to identify an unauthorized user from biometric data. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Deo is used to show a portable computing device having authorization data stored in memory which can be removed upon instructions from a remote station. That the authorization data can be biometric

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data is rendered obvious from Borza's teaching that biometric data is used for authorization.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borza et al (WO 98/12670) in view of Deo et al (US 6,496,928).

**Claim 1:**

Borza discloses:

1. Gaining access to said computer network by use of a portable computing device (p5, lines 18-24)
2. Reading biometric data peculiar to a user by the use of a biometric data reader coupled to said portable computing device (p8, lines 16-17 and p9, lines 11-15).
3. Comparing said biometric data peculiar to said user to previously biometric data stored in said portable computing device and said computer network for the purpose of identifying the user (p8, lines 1-2, 27-28 and p15, lines 10-25).
4. A remotes station retaining a copy of said biometric data (p8, lines 27-28 and p15, lines 10-25).

5. Denying further access to said computer network if said comparing step fails to identify said user as an authorized user (p15, lines 10-25 and Fig 8, item 40).

Borza does not disclose "wherein said biometric data is operable to be removed from said portable computing device on instruction by a remote station on said computer network". However, Deo discloses a remote station transmitting a programming message to a portable computing device with instructions for the portable computing device to remove authorization data from its memory (col 24, lines 3-17). The examiner asserts that biometric data as disclosed by Borza is authorization data. Therefore, in light of the above, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Borza's invention according to the limitations recited in claim 1. One of ordinary skill would have been motivated to do so as Deo discloses that his teachings would allow for a content provider or wireless carrier with the ability to turn off services to individual users of mobile devices (col 28, lines 49-52), which provides efficient subscription management (col 22, lines 47-48). This would allow Borza more flexible security control over the portable computing devices using his invention including the ability to remotely disable the computing devices if they were stolen.

**Claim 2:**

Borza further discloses wherein said access to said computer network is by use of a wireless connection (p7, lines 28-30).

**Claim 3:**

Borza further discloses said biometric data is a fingerprint (p9, lines 13-15).

**Claim 4:**

Borza further discloses wherein said biometric data is an iris scan (p11, lines 18-21).

**Claim 5:**

Borza further discloses wherein said biometric data comprises one or more measured electrical characteristics (p8, lines 13-17).

**Claim 6:**

Borza does not disclose said biometric data can be programmed into said portable computing device by a remote station on said computer network. However, as mentioned, biometric data is authorization data. Further, Deo discloses authorization data can be programmed into a portable computing device by a remote station on a computer network (col 23, lines 19-24). Therefore, the above limitation is obvious to the combination invention of Borza and Deo

**Claim 8:**

Borza discloses:

1. Reading biometric data peculiar to a user (p8, lines 16-17 and p9, lines 11-15).
2. Comparing said biometric data with previously stored biometric data for purpose of identifying the user (p8, line 19-p9 line 2).
3. A remote station retaining a copy of said previously stored biometric data (p8, lines 27-28 and p15, lines 10-25).

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4. Preventing access if the user is not identified as an authorized user (p15, lines 10-25 and Fig 8, item 40).

Borza does not disclose wherein said previously stored biometric data is operable to be removed from said portable computing device on instructions by a remote station. However, Deo discloses a remote station transmitting a programming message to a portable computing device with instructions for the portable computing device to remove authorization data from its memory (col 24, lines 3-17). The examiner asserts that biometric data as disclosed by Borza is authorization data. Therefore, in light of the above, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Borza's invention according to the limitations recited in claim 8. One of ordinary skill would have been motivated to incorporate Deo's teachings for the same reasons given in claim 1.

**Claim 9:**

Claim 9 recites a limitation substantially similar to claim 3 and is rejected for the same reasons.

**Claim 10:**

Claim 10 recites a limitation substantially similar to claim 4 and is rejected for the same reasons.

**Claim 11:**

Claim 11 recites a limitation substantially similar to claim 5 and is rejected for the same reasons.



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**Claim 12:**

Claim 12 recites a limitation substantially similar to claim 6 and is rejected for the same reasons.

**Claim 13:**

Borza discloses:

1. A computer network, said computer network comprising one or more computer workstations, wherein access to said computer network is provided by said one or more workstations (p8, line 27-p9, line 1).
2. A portable computing device, said portable computing device providing wireless access to said computer network (p7, line 27-p8, line 3).
3. A biometric data reading device coupled to said portable computing device (p8, lines 16-17).
4. A data storage device for storing biometric data capable of identifying one and only one user (p8, line 27-p9, line 2).
5. Said one of said one or more workstations retaining a copy of said biometric data (p8, lines 27-28 and p15, lines 10-25).

Borza does not disclose a wireless communication device coupled to said computer network, capable of enabling the loading and removing of said biometric data stored in said portable computing device, and wherein said biometric data is operable to be removed from said portable computing device on instructions by one of said one or more workstations on said computer network.

However, Deo discloses a wireless communication device coupled to said computer network, capable of enabling the loading and removing of authorization data stored in said portable computing device (col 23, lines 19-24 and col 24, lines 3-17), and wherein said authorization data is operable to be removed from said portable computing device on instructions by one of said workstations on said computer network (col 23, lines 19-24).

In light of the above, it would have been obvious to one of ordinary skill in the art to have modified Borza's invention according to the limitations recited in claim 13. One of ordinary skill would have been motivated to incorporate Deo's teachings for the same reasons given in claim 1.

**Claim 14:**

Borza further discloses said portable computing apparatus comprises:

1. A bus (Fig 6).
2. A memory unit coupled to said bus (p9, lines 1-2).
3. A data storage device coupled to said bus, capable of storing said biometric data (p9, lines 1-2).
4. A biometric data reader coupled to said bus (p8, lines 16-17).
5. A communication device coupled to said bus for communicating with a computer network (Fig 6, item 19).
6. A processor couple to said bus (Fig 6, item 12), said processor for performing a method for identifying a user by use of said biometric data, said method comprising the steps of:

- a. Reading applicable biometric data (p3, lines 27-30).
- b. Comparing said biometric data with said biometric data in said memory unit (p3, lines 27-30).

**Claim 15:**

Borza does not disclose said portable computing apparatus is a personal data assistant (PDA). However, the limitation is obvious to the combination invention of Borza and Deo as Deo discloses portable computing apparatus are personal data assistants (col 1, lines 27-28).

**Claim 16:**

Borza further discloses said biometric data reader is implemented as part of the portable computing apparatus (p8, lines 16-17).

**Claims 17 and 18:**

Claims 17 and 18 recite limitations substantially similar to claims 3 and 4 respectively and are rejected for the same reasons.

**Claim 19:**

Borza further discloses said biometric data is any electronically storable identifying biometric data (p8, lines 13-17).

**Claim 20:**

Claim 20 is substantially similar to claim 5 and is rejected for the same reasons.

**Claim 21:**

Borza further discloses said computer network further comprises a remote station connected to said computer network (p8, lines 19-20 and line 29-p9, line 1).

**Claim 22:**

Borza further discloses wherein said remote station is for performing a method of network access control (p8, lines 27-29). Borza further discloses said method comprising uploading said biometric data from said portable computing apparatus (p8, lines 19-20). Borza does not disclose said method comprising:

1. Downloading said biometric data to said portable computing device.
2. Erasing said biometric data from said portable computing apparatus.

However, the examiner asserts that biometric data is authorization data. Further, Deo discloses downloading authorization data to a portable computing apparatus and erasing authorization data from a portable computing apparatus (col 23, lines 19-24 and col 24, lines 3-17). Therefore, the above limitations not met by Borza are obvious to the combination invention of Borza and Deo.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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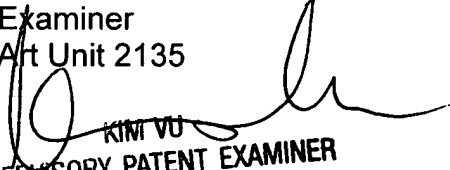
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PP

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